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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,443	03/14/2004	James E. Chitwood		1787

24245 7590 06/03/2005

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EXAMINER
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BEACH, THOMAS A

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/800,443

**Applicant(s)**

CHITWOOD ET AL.

**Examiner**

Thomas A Beach

**Art Unit**

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Costa Filho 5,289,561. Costa Filho shows a flowline for producing hydrocarbons from a subsea well that is comprised of a substantially neutrally buoyant tubular 78 composite umbilical means that possesses electrical heating means 31 within the tubular walls of the tubular composite umbilical means to prevent waxes and hydrates from forming within the flowline and blocking the flowline (fig.1 and 6-7), whereby the electrical heating means is comprised of at least one electrical conductor disposed within the

tubular walls of the composite umbilical means that conducts electrical current that is used to heat the tubular composite umbilical means, and whereby the tubular composite umbilical means that contains any produced hydrocarbons is substantially neutrally buoyant (fig. 1) in the sea water adjacent to the subsea well.

As concerns claim 2, Costa Filho shows a method of using a flowline for producing hydrocarbons from a subsea well that is comprised of a substantially neutrally buoyant tubular composite umbilical means that possesses electrical heating means 31 within the tubular walls of the tubular composite umbilical means to prevent waxes and hydrates from forming within the flowline and blocking the flowline (fig.1 and 6-7), whereby the electrical heating means is comprised of at least one electrical conductor disposed within the tubular walls of the composite umbilical means that conducts electrical current that is used to heat the tubular composite umbilical means, and whereby the tubular composite umbilical means that contains any produced hydrocarbons is substantially neutrally buoyant in the sea water adjacent to the subsea well.

As concerns claim 4, Costa Filho shows a flowline for producing hydrocarbons from a subsea well that is comprised of a positively buoyant tubular composite umbilical means that possesses electrical heating means 31 within the tubular walls of the tubular composite umbilical means to prevent waxes and hydrates from forming within the flowline and blocking the flowline (fig.1 and 6-7), whereby the electrical heating means is comprised of at least one electrical conductor disposed within the tubular walls of the composite umbilical means that conducts electrical current that is used to heat the

tubular composite umbilical means, and whereby the tubular composite umbilical means that contains any produced hydrocarbons is positively buoyant in the sea water adjacent to the subsea well.

As concerns claim 5, Costa Filho shows a method of using a flowline for producing hydrocarbons from a subsea well that is comprised of a positively buoyant tubular composite umbilical means that possesses electrical heating means 31 within the tubular walls of the tubular composite umbilical means to prevent waxes and hydrates from forming within the flowline and blocking the flowline (fig.1 and 6-7), whereby the electrical heating means is comprised of at least one electrical conductor disposed within the tubular walls of the composite umbilical means that conducts electrical current that is used to heat the tubular composite umbilical means, and whereby the tubular composite umbilical means that contains any produced hydrocarbons is positively buoyant in the sea water adjacent to the subsea well.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 3 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Coats 6,615,848. As concerns claim 3, Coats shows a flowline for producing hydrocarbons from a subsea well that is comprised of a substantially neutrally buoyant tubular composite umbilical means (figures 1-2), whereby the tubular composite umbilical means that contains anyproduced hydrocarbons is substantially neutrally buoyant in the sea water adjacent to the subsea well (abstract).

As concerns claim 6, Coats shows a flowline for producing hydrocarbons from a subsea well that is comprised of a positively buoyant tubular composite umbilical means, whereby the tubular composite umbilical means (figures 1-2) that contains any produced hydrocarbons is positively buoyant in the sea water adjacent to the subsea well (abstract).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A Beach whose telephone number is 571-272-6988. The examiner can normally be reached on Monday-Thursday, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached at 571-272-6998. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703.872.9306 for regular communications and 703.872.9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.4198.

Thomas A. Beach

May 31, 2005

**THOMAS A. BEACH**  
Patent Examiner  
Group 3600